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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/623,222 | 07/21/2003 | Karl Gramling | P-7988 | 2742 |

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EXAMINER

KATCHEVES, BASIL S

ART UNIT PAPER NUMBER

3635

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,222

Applicant(s)

GRAMLING, KARL

Examiner

Basil Katcheves

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9, 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Marked fig. 4.

DETAILED ACTION

Claim Objections

Claims 1-10 are objected for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the language between the preamble and certain portions of the body of the claim are inconsistent. The claim is drawn to a subcombination gutter clip but then recites a gutter and retaining member setting forth a positive relation appearing to be a combination. Applicant should note the claims have been examined assuming a combination. Clarification is required. Claims 2-8 depend from claim 1.

Regarding claim 9, the claim is drawn to a subcombination gutter clip but then recites limitations of a retaining member setting forth a positive relation between the clip and retaining member appearing to be a combination. Applicant should note the claims have been examined assuming a combination. Clarification is required.

Regarding claim 10, the claim is drawn to a subcombination gutter clip but then recites limitations of a gutter setting forth a positive relation between the clip and gutter appearing to be a combination. Applicant should note the claims have been examined assuming a combination. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent No. 5,960,591 to Schluter.

Regarding claim 1, Schluter discloses a gutter retaining system comprised of a clip, a retaining member, and a gutter. Schluter also discloses the gutter clip as having a locking tip contiguous with a nib end, the nib end being adjacent to a hanger portion, the hanger portion being contiguous to a U portion, the U portion being adjacent to a vertical portion, the hanger portion and vertical portion being approximately parallel and the nib end is angled outward from the hanger portion and the locking tip is angled inward toward the vertical portion whereby the clip is locked within and between the gutter and retaining member (see attached marked fig. 4).

Regarding claim 2, Schluter discloses a base adjacent the vertical portion (see attached marked fig. 4).

Regarding claim 3, Schluter discloses an extension adjacent the base (see attached marked fig. 4).

Regarding claim 4, Schluter discloses a back face mounted against the gutter back wall (see attached marked fig. 4).

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Regarding claim 5, Schluter discloses a first elbow between the vertical portion and the base (see attached marked fig. 4).

Regarding claim 6, Schluter discloses a second elbow between the base and the extension (see attached marked fig. 4).

Regarding claim 7, Schluter discloses a lower U portion adjacent to the extension (see attached marked fig. 4).

Regarding claim 8, Schluter discloses an end adjacent the lower U portion (see attached marked fig. 4).

Claim Objections

Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The indication of allowable subject matter is provisional and subject to reconsideration upon receipt of the amended claims to comply with the objections pointed out above".

Claim 10 is objected to for depending from claim 9.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited patents listed on the included form PTO-892 further show the state of the art with respect to gutter clips in general.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (703) 306-0232. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman, can be reached at (703) 308-0832.

BK


Basil Katcheves

9/27/04

Examiner AU 3635